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PATENT
Customer No. 34,986
Attorney Docket No. 01064.0011-05-000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:)
Richard LEVY) Group Art Unit: 1714
Application No.: 09/359,809) Examiner: Cephia Toomer
Filed: July 23, 1999)
For: LUBRICANT COMPOSITIONS AND)
METHODS)

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

SECOND SUBMISSION OF APPELLANT'S BRIEF ON APPEAL

After one month, The Patent and Trademark Office's PAIR system has not posted appellant's July 31, 2006 Brief on Appeal, and accordingly, appellant now submits a copy of the July 31, 2006 Brief since the original Brief does not appear in the Patent Office's files. The copy of the July 31, 2006 Brief that follows also includes the facsimile transmission report showing appellant's attorneys sent it to the Patent Office by facsimile on July 31, 2006; however, in order to avoid paying filing fees twice, the attached copy of the brief doesn't include PTO Form 2038 included with the originally filed Brief.

Respectfully submitted,

THE LAW OFFICES OF ROBERT J. EICHELBURG

August 28, 2006

By: /Robert J. Eichelburg, Reg. No. 23,057/
Robert J. Eichelburg

CERTIFICATE OF FACSIMILE TRANSMISSION PURSUANT TO 37 C.F.R. § 1.6 (d)

I hereby certify that this correspondence and the aforementioned FORM PTO 2038 is being transmitted pursuant to 37 C.F.R. § 1.6(d) by facsimile to The United States Patent and Trademark Office at their Central FAX Number, (571) 273-8300, on the date indicated below.

Dated: August 28, 2006

By: /Robert J. Eichelburg, Reg. No. 23,057/
Robert J. Eichelburg

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PATENT
CUSTOMER NUMBER, 34,986
Docket No. 01064.0011-05000

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:

Richard LEVY

Serial No.: 09/359,809

Filed: July 21, 1999

For: LUBRICANT COMPOSITIONS AND
METHODS

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) Group Art Unit: 1714
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) Examiner: Cephia Toomer
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Commissioner for Patents
P. O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

APPELLANT'S BRIEF ON APPEAL PURSUANT TO 37 C.F.R. § 41.37

Appellant submits the following brief to perfect the appeal filed on May 30, 2006. The brief sets forth the authorities and arguments on which appellant will rely to maintain the appeal.

Appellant paid the \$160.00 fee (small entity) required by 37 C.F.R. § 41.20(b) (2), at the time of filing the August 12, 2002 brief in this application. The Manual of Patent Examining Procedure (M.P.E.P.) §1204.01 waives \$160.00 of the \$250.00 fee now due for filing this brief. Appellant therefore includes payment of the \$90.00 difference with the filing of this brief.

(i) Real Party In Interest

The inventor assigned the parent application Serial No. 08/487,436, filed June 7, 1995 to Lee County Mosquito Control District. The assignment was recorded at reel 7878, frame 0620 on August 23, 1995, which makes Lee County Mosquito Control District the real party in interest.

(ii) **Related Appeals and Interferences**

Appellant has the following co-pending appeals before the Board of Patent Appeals and Interferences in related applications:

Serial No. 10/614,114

Filed July 7, 2003

Serial No. 08/943,125

Filed October 3, 1997

The Patent and Trademark Office (PTO) has labeled the cover of their file for application Serial No. 08/943,125 as follows:

U. S. PATENT AND TRADEMARK OFFICE
RETURN TO (PTO 1056)
INTERFERENCE SERVICE BRANCH
This case is involved in an
Interference Proceeding

Appellant's August 12, 2002 brief attached as Exhibit 1, a photocopy of a certified copy of the PTO cover of application Serial No. 08/943,125. The Patent and Trademark Office has not notified appellant that they have declared an interference in any of the foregoing applications, even though they indicated on the file of application Serial No. 08/943,125 "[t] his case is involved in an Interference Proceeding." The Board also advised, when contacted by appellant's attorneys by telephone, that the Patent Office had not declared an interference in application Serial No. 08/943,125. Lastly, the Board's decision in the pending appeal could directly affect, or be directly affected by, or having a bearing on the decision in the co-pending appeals.

Appellant calls the Board's attention to the United States Patent Application of Martin C. Flautt et al., Serial No. 09/190,866 filed November 13, 1998. Appellant advised the examiner that appellant's Application Serial No. 09/779,588 copies claims from the corresponding Flautt et al. PCT Application WO 00/29486. The Patent and Trademark Office, as of the filing of this brief, has not declared an interference between appellant's Application Serial No. 09/779,588, and Flautt et al., Serial No. 09/190,866.

(iii) Status of Claims

As of August 31, 2005 appellant had cancelled claims 1-72 without prejudice or disclaimer, leaving claims 73 - 100 in the application.

(iv) Status of Amendments

The examiner has entered appellant's August 31, 2005 amendment to claims 73, 76, 77, 80-83, and 90.

(v) Summary of Claimed Subject Matter

The invention comprises a process of making a lubricant and a lubricant composition of matter consisting essentially of a product produced by a process (written description, page 21, lines 6-8.) of combining a superabsorbent polymer that absorbs greater than about 100 times its weight in water with a material for decreasing friction between moving surfaces where the material is a petroleum oil lubricant, or grease thereof, a solid inorganic compound, a solid organic compound, water containing a lubricant additive, a phosphate, a fatty oil, fatty acid or wax, a synthetic oil lubricant, or grease thereof, or a soap, and mixtures thereof. The lubricant additives include without limitation, an oxidation inhibitor, a rust inhibitor, anti-wear agent, detergent-dispersant, pour-point depressant, viscosity-index improver or foam inhibitor. (Written Description, paragraph bridging pages 19 and 20, and page 20, first full paragraph.)

Claim 73 describes the metal nitride material for lubricating a surface as a particulate material which the written description of the parent application supports at page 17, paragraph two. Claim 73 also describes the lubricating material as a silicate which the written description of the parent application supports at page 14, first full paragraph and page 24 last paragraph by the recitation of the materials "asbestos," and "talc," and page 15 first full paragraph, line 3 and page 24, line 6 from the bottom by the disclosure of "mica." Claims 77 and 83 specifically claim "asbestos," "mica," and "talc" as lubricating materials. Claims 73 and 76 include a chalcogen compound as a lubricating material, which the written description of the parent application supports at page 17, paragraph two.

Claim 73 lubricating materials include the "silicate, . . . phthalocyanine" components as "compounds," and the material for lubricating a surface as optionally including an additional lubricant such as an "organic lubricant. . . ." The written description of the parent application supports the phrase "mixtures thereof" in subparagraph "(4)" of claim 73 to indicate that the invention includes mixtures of lubricants. Page 23, penultimate paragraph states that the invention relates to "various mixtures of each of the foregoing lubricants. . . ." whereas page 25 first paragraph notes that "mixtures of the solid or particulate lubricants (of the invention) can be used. . . ." and paragraph 2 notes that the invention also includes the use of "mixtures of the organic lubricants. . . ." Appellant also points out that the paragraph bridging pages 25 and 26 of the parent application describes "mixtures of the solid or particulate organic lubricants. . ." which, and that the first full paragraph on page 26 further describes the lubricants of the invention as "combinations of the solid or particulate inorganic lubricant and the solid or particulate organic lubricant. . . ."

Page 12, first full paragraph of the present application supports the claim 73 phosphate of subparagraph "(2)" of this claim defined as an "organic phosphate."

Claims 80-82 describe the superabsorbent polymer as comprising "a polymer of acrylic acid, an acrylic ester, acrylonitrile, acrylamide, co-polymers thereof or mixtures thereof" which claim 90 supports.

(vi) **Grounds of Rejection to be Reviewed on Appeal**

- a. Whether the judicially created doctrine of obviousness-type double patenting applies to claims 73 -100 taken in view of claims 57-90 of copending application Serial No. 10/614,114 filed July 7, 2003 and claims 90 -115 of copending application Serial No. 10/763,687 filed January 24, 2004.

- b. Whether the examiner has properly applied 35 U.S.C. 112, first paragraph in rejecting claim 89 relating to a substantially anhydrous composition.
- c. Whether Takayama, United States Patent No. 5,792,717 supports the examiner's rejection of claims 73, 74, 76, 77 and 90 under 35 U.S.C. § 103(a);
- d. Whether Johnson, United States Patent No. 5, 275,760 in view of Obayashi et al. United States Patent No. 4,340,706 ("Obayashi") support the examiner's rejection of claims 73-76, 80-82, 86, 87, 89-93, 96, 99, and 100 under 35 U. S. C. § 103 (a);

(vii) **Argument**

The Provisional Double Patenting Rejection

The examiner provisionally rejects claims 73-100 under the judicially created doctrine of obviousness-type double patenting based on copending applications Serial No. 10/614,114 filed July 7, 2003 and Serial No. 10/763,687 filed January 24, 2004. Appellant traverses the rejection since neither copending application has issued as a patent, and further requests allowance if neither of the copending applications issues, and the only rejection remaining in the present application consists of the provisional obviousness-type double patenting rejection. If one of the co-pending applications issues as a patent, appellant reserves the right to distinguish the claims in this application from the claims of the copending application or applications in the event this application still remains as a pending application at the time of issue of one of the other applications.

Appellant should not be required to file a terminal disclaimer in the present application since the Patent Office may not allow the copending applications (Serial No. 10/614,114 filed July 7, 2003 and Serial No. 10/763,687 filed January 24, 2004) which form the basis of the double patenting rejection. When a provisional double patenting rejection is the sole remaining rejection in an earlier filed application, (the present application, Serial No. 09/359,809, filed July 21, 1999) and the present application is otherwise in condition for allowance, the M.P.E.P. states that the examiner should withdraw the rejection in the application and permit it to issue as a patent. M.P.E.P. § 804(I) (B).

The Rejection Under 35 U.S.C. §112 First Paragraph

The examiner rejects claim 89 allegedly for lacking support in the specification for a composition that is substantially anhydrous. Appellant previously pointed out that the written description of the parent application supports a composition that is substantially anhydrous at p. 29, 2nd par., but the examiner, upon reviewing appellant's argument in view of this part of the written description states "[t]hat the composition may have the consistency of grease is not adequate support for a substantially anhydrous composition." (May 24, 2006 Office communication, page 4, par. 4). The examiner apparently did not refer to the parent application, but rather the present application page 29 discussion. But the present application also discusses this phenomenon at pages 31 and 32 as follows:

The lubricant and additives, when employed, are combined with the superabsorbent polymer by swelling the polymer either by itself or dispersed with the lubricant (and additives when employed), either in water or in a high humidity environment, e.g. 80% R.H.

Prior to, or after exposing the superabsorbent polymer to water or humidity, the polymer, in the form of a powder, flakes or granules is mixed with the lubricant in a conventional mixer, such as a HOBART™ mixer until a uniform dispersion is obtained. This process may be facilitated by employing a solvent or dispersant for the lubricant, preferably in some instances, one that will be easily driven off from the lubricant composition of the invention, such as a

ketone, especially the lower alkyl ketones e.g. acetone MEK, MIBK, DIBK, and the like.

The lubricant then combines with, is entrapped by or is taken up by the superabsorbent polymer that has been swollen with water or in high humidity. The lubricant composition is then dried to remove the water, for example by placing it in a 27-38% R.H. environment, or under vacuum or at elevated temperatures. This removes substantially all of the water introduced in the first part of the process. (emphasis added)

The Rejection Under 35 U.S.C. §103 (a)

The examiner rejects claims 73, 74, 76, 77, and 90 under 35 U. S. C. § 102 (e) as obvious in view of Takayama, United States Patent No. 5,792,717. The examiner cites Takayama for the disclosure of a monolithic boron nitride ceramic body article of manufacture that has open pores filled with a water absorbing resin. This is not appellant's particulate boron nitride composition combined with a superabsorbent resin. Claiming the metal nitride as a particulate material distinguishes Takayama which describes an article of manufacture based on a boron nitride monolith or ceramic.

To apply this reference to reject the present claims would require taking the Takayama article and using it to lubricate a substrate, e.g., putting the Takayama article of manufacture between two sliding surfaces that frictionally engage one another. Standing by itself, it does not teach appellant's claimed particulate composition.

The examiner also states that " Takayama teaches the composition has lubricity properties (see col.4, lines 30-43)." (May 24, 2006 Office communication, p. 5, 2nd par.) Appellant respectfully disagrees. This section of the Takayama reference only describes the porosity of the monolithic ceramic substrate. It does not say anything about the lubricity of the combination, but only that water can provide increased lubrication by impregnating a water absorbing polymer into the porous ceramic in increased amounts. The inventor achieves this by employing a monolithic ceramic material with relatively high porosity. Takayama therefore does not obviate appellant's claimed particulate metal nitride lubricating composition.

The examiner rejects claims 73-76, 80-82, 86, 87, 89-93, 96, 99, and 100 under 35 U. S. C. § 103 (a) as unpatentable over Johnson, United States Patent No. 5, 275,760 in view of Obayashi et al. United States Patent No. 4,340,706 ("Obayashi").

Johnson does not teach or suggest:

A lubricating composition of matter comprising a polymer, where the polymer comprises a superabsorbent polymer that absorbs greater than about 100 times its weight in water combined with a material for lubricating a surface wherein the material for lubricating a surface comprises:

(1) a lubricating metal and alloy thereof, a lubricating metal chalcogenide, halide, carbonate, silicate or phosphate, or a particulate lubricating metal nitride, or a carbon lubricant; or

(2) a silicate ester, polyphenyl ether, organic phosphate, biphenyl, phenanthrene, or phthalocyanine compound;

(3) where the material for lubricating a surface optionally contains a lubricant comprising an, organic lubricant, inorganic lubricant, or water, or a lubricant additive; or

(4) mixtures thereof.

On the contrary, Johnson describes the use of "oils" with a polymer, noting that "[o]ils are a suitable carrier medium [that] . . . include fixed oils such as glycerol fatty acids, lubricating oils, mineral oils, hydrocarbon oils such as crude petroleum, residual refinery oils from bottom streams, diesel oils, fuel oils and the like. In the present method, a food grade mineral oil is preferred. . . ." (Johnson, col. 4, lines 24-29). These bear no chemical resemblance to the claim 73 inorganic materials for lubricating a surface or the "silicate ester, polyphenyl ether, organic phosphate, biphenyl, phenanthrene, or phthalocyanine compound" class of materials for lubricating a surface.

The examiner correctly distinguishes the broader teachings of Johnson at page 6 of her May 24 Office communication, i. e., Johnson fails to teach appellant's intended use, although the examiner argues intended use does not lend patentable weight to appellant's invention, and Johnson fails to teach superabsorbent polymers, i.e., polymers that absorb more than about 100 times their weight in water. Appellant nonetheless distinguishes the reference not only for the reasons given by the examiner, but also as noted above because it fails to teach or suggest the use of an inorganic lubricating material or the "silicate ester, polyphenyl ether, organic phosphate, biphenyl, phenanthrene, or phthalocyanine compound" class of materials for lubricating a surface. Obayashi does not overcome these deficiencies of the Johnson reference.

Conclusions

Appellant requests the Board to reverse the examiner in all respects and remand the application to the examiner for the issuance of a Notice of Allowance. If the Board overrules the prior art and 35 U.S.C. § 112 rejections in this application and sustains the provisional double patenting rejection, appellant similarly requests the Board to remand the application to the examiner for issuance of a Notice of Allowance pursuant to M.P.E.P. § 804(l)(B).

Respectfully submitted,

THE LAW OFFICES OF ROBERT J. EICHELBURG

By: / Robert J. Eichelburg, Reg. No 23,057/

Dated: July 31, 2006

Robert J. Eichelburg

(viii) Claims Appendix

Claim 73 A process for manufacturing a lubricant composition comprising a polymer where said polymer comprises a superabsorbent polymer that absorbs more than about 100 times its weight in water, by combining said polymer with a material for lubricating a surface wherein said material for lubricating a surface comprises:

- (1) a lubricating metal and alloys thereof, a lubricating metal chalcogen compound, halide, carbonate, silicate or phosphate, or a particulate lubricating metal nitride, or a carbon lubricant; or
- (2) a silicate ester, polyphenyl ether, organic phosphate, chlorinated biphenyl, phenanthrene or phthalocyanine compound;
- (3) said material for lubricating a surface optionally containing a lubricant comprising an, organic lubricant, inorganic lubricant, or lubricant additive;
- (4) or mixtures thereof.

Claim 74 A lubricant composition of matter comprising a product produced by the process of claim 73.

Claim 75 The lubricant product of claim 74 wherein said organic lubricant comprises a petroleum oil lubricant or grease thereof, a fatty oil, fatty acid, wax, synthetic oil lubricant or grease thereof, two-mol ethoxylate of isostearyl alcohol, a soap, a polymerized olefin, or an organic ester and wherein said composition optionally comprises a lubricant additive, or mixtures thereof.

Claim 76 A lubricant composition of matter comprising a product produced by the process comprising forming a mixture comprising a polymer where said polymer comprises a

superabsorbent polymer, said mixture further comprising a material for lubricating a surface, wherein said superabsorbent polymer absorbs more than about 100 times its weight in water and wherein said material for lubricating a surface comprises a solid lubricant comprising a metal alloy, an inorganic chalcogen compound, halide, nitride, carbonate, phosphate compound, carbon lubricant, or metal material that provides barrier-layer lubrication, or mixtures thereof, and wherein said composition optionally comprises a lubricant additive.

Claim 77 The lubricant composition of claim 76, wherein said material for lubricating a surface comprises, molybdenum disulfide, cobalt chloride, antimony oxide, niobium selenide, tungsten disulfide, boron nitride, silver sulfate, cadmium chloride, cadmium iodide, cadmium oxide, borax, basic white lead, lead carbonate, lead monoxide, lead iodide, asbestos, talc, mica, zinc oxide, zinc phosphate, iron phosphate, manganese phosphate, carbon, graphite, babbitt, bronze, brass, aluminum, gallium, indium, thallium, thorium, copper, silver, gold, mercury, lead, tin, indium, or the Group VIII noble metals or mixtures thereof.

Claim 78 The lubricant composition of claim 74 wherein said organic lubricant comprises a solid organic lubricant.

Claim 79 The lubricant composition of claim 78, wherein said solid organic lubricant comprises a fluoroalkylene homopolymer or copolymer, a lower alkylene polyolefin homopolymer or co-polymer, a paraffinic hydrocarbon wax, phenanthrene, copper phthalocyanine, or mixtures thereof.

Claim 80 A lubricant composition of matter comprising a product produced by the process comprising forming a mixture comprising a polymer where said polymer comprises a superabsorbent polymer, wherein said superabsorbent polymer comprises a polymer of acrylic

acid, an acrylic ester, acrylonitrile, acrylamide, co-polymers thereof or mixtures thereof, said mixture further comprising a material for lubricating a surface, wherein said superabsorbent polymer absorbs more than about 100 times its weight in water, and wherein said material for lubricating a surface comprises water containing a lubricant additive.

Claim 81 A lubricant composition of matter comprising a product produced by the process comprising forming a mixture comprising a superabsorbent polymer, wherein said superabsorbent polymer comprises a polymer of acrylic acid, an acrylic ester, acrylonitrile, acrylamide, co-polymers thereof or mixtures thereof, said mixture further comprising a material for lubricating a surface, wherein said superabsorbent polymer absorbs more than about 100 times its weight in water, and wherein said material for lubricating a surface comprises an oil or greases thereof and water, and wherein said composition optionally comprises a lubricant additive.

Claim 82 A lubricant composition of matter comprising a product produced by the process comprising forming a mixture comprising a polymer where said polymer comprises a superabsorbent polymer, wherein said superabsorbent polymer comprises a polymer of acrylic acid, an acrylic ester, acrylonitrile, acrylamide, co-polymers thereof or mixtures thereof, said mixture further comprising a material for lubricating a surface, wherein said superabsorbent polymer absorbs more than about 100 times its weight in water, wherein said material for lubricating a surface comprises a solid lubricant and water, and wherein said composition optionally comprises a lubricant additive.

Claim 83 The lubricant composition of claim 82, wherein said solid lubricant comprises molybdenum disulfide, cobalt chloride, antimony oxide, niobium selenide, tungsten disulfide, boron nitride, silver sulfate, cadmium chloride, cadmium iodide, cadmium oxide, borax, basic

white lead, lead carbonate, lead monoxide, lead iodide, asbestos, talc, mica, zinc oxide, zinc phosphate, iron phosphate, manganese phosphate, carbon, graphite, babbitt, bronze, brass, aluminum, gallium, indium, thallium, thorium, copper, silver, gold, mercury, lead, tin, indium, the Group VIII noble metals, a fluoroalkylene homopolymer or copolymer, a lower alkylene polyolefin homopolymer or co-polymer, a paraffinic hydrocarbon wax, phenanthrene, copper phthalocyanine, or mixtures thereof.

Claim 84 A lubricant composition of matter comprising a product produced by the process comprising forming a mixture comprising a polymer where said polymer comprises a superabsorbent polymer, said mixture further comprising a material for lubricating a surface, wherein said superabsorbent polymer absorbs more than about 100 times its weight in water, wherein said material for lubricating a surface comprises a phosphate, and wherein said composition optionally comprises a lubricant additive.

Claim 85 The lubricant composition of claim 84, wherein said material for lubricating a surface comprises tricresyl phosphate, zinc phosphate, iron phosphate or manganese phosphate, or mixtures thereof.

Claim 86 The lubricant composition of claim 74 wherein said organic lubricant comprises a fatty oil, fatty acid, or wax, or mixtures thereof, and wherein said composition optionally comprises a lubricant additive.

Claim 87 The lubricant composition of claim 74 wherein said organic lubricant comprises a synthetic oil lubricant, or grease thereof, and wherein said composition optionally comprises a lubricant additive.

Claim 88 The lubricant composition of claim 74 wherein said organic lubricant comprises a soap, and wherein said composition optionally comprises a lubricant additive.

Claim 89 The composition of any one of claims 73-79, and 84-88 wherein said composition is substantially anhydrous.

Claim 90 The composition of any one of claims 73-79, and 84-88 wherein said superabsorbent polymer comprises a polymer of acrylic acid, an acrylic ester, acrylonitrile, acrylamide, co-polymers thereof or mixtures thereof.

Claim 91 The composition of any one of claims 75-88 wherein said lubricant additive comprises an antioxidant, rust inhibitor, antiwear compound, extreme pressure additive, detergent, dispersant, pour point depressant, viscosity-index improver, or foam inhibitor, or mixtures thereof.

Claim 92 The composition of claim 75 wherein said organic lubricant comprises a petroleum oil lubricant or grease thereof.

Claim 93 The composition of claim 75 wherein said organic lubricant comprises a fatty oil.

Claim 94 The composition of claim 75 wherein said organic lubricant comprises a fatty acid.

Claim 95 The composition of claim 75 wherein said organic lubricant comprises a wax.

Claim 96 The composition of claim 75 wherein said organic lubricant comprises a synthetic oil lubricant or grease thereof.

Claim 97 The composition of claim 75 wherein said organic lubricant comprises a two-mol ethoxylate of isostearyl alcohol.

Claim 98 The composition of claim 75 wherein said organic lubricant comprises a soap.

Claim 99 The composition of claim 75 wherein said organic lubricant comprises a polymerized olefin.

Claim 100 The composition of claim 75 wherein said organic lubricant comprises an organic ester.

CERTIFICATE OF FACSIMILE TRANSMISSION PURSUANT TO 37 C.F.R. § 1.6 (d)

I hereby certify that the foregoing Brief on Appeal and the attached FORM PTO 2038 is being transmitted pursuant to 37 C.F.R. § 1.6(d) by facsimile to The United States Patent and Trademark Office, facsimile telephone number (571) 273-8300 on the date indicated below.

By: /Robert J. Eichelburg, Reg. No. 23,057/
Robert J. Eichelburg

Dated: July 31, 2006